

## **REMARKS**

In the outstanding Office Action, the Examiner rejected claims 9-11, 13, and 15-16 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,472,735 to Isaak ("Isaak"); rejected claims 9-12 and 16 under 35 U.S.C. § 102(e) as being anticipated by Japanese Patent Application Kokai Publication No. 2001-68624 to Imoto ("Imoto"); rejected claims 19-20 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,577,013 to Glenn et al. ("Glenn"); and rejected claim 14 under 35 U.S.C. § 103(a) as being unpatentable over Imoto in view of Glenn.

By this amendment, Applicant has amended claim 9 and canceled claims 19-20. Claims 1-18 remain pending, with claims 9-16 currently presented for examination.

### **I. Rejections under 35 U.S.C. § 102**

Regarding the rejection of claims 9-13, 15, 16, 19, and 20 under 35 U.S.C. § 102, Applicant respectfully disagrees with the Examiner's arguments and conclusions as set forth in the outstanding Office Action<sup>1</sup>. Accordingly, Applicant respectfully traverses this rejection.

In order to properly anticipate Applicant's claimed invention under 35 U.S.C. §102, each and every element of the claim in issue must be found, "either expressly or inherently described, in a single prior art reference." "The identical invention must be shown in as complete detail as is contained in the . . . claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)." See M.P.E.P. § 2131, 8th Ed. (Rev. 2), May, 2004.

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<sup>1</sup> The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement of characterization in the Office Action.

A. Isaak

Claim 9 recites a combination of elements including “a first connection portion spaced from the first connection terminals and not electrically connected to any terminal of the integrated circuit chip,” and “a metal material portion ... not electrically connected to any terminal of the integrated circuit chip.” Isaak fails to teach at least these elements.

At page 2 of the Office Action, the Examiner states that Isaak teaches “a first connection portion (consider through hole 32 formed in 1<sup>st</sup> substrate 14,” and at page 3 of the Office Action, the Examiner further characterizes Isaak as teaching “a metal material portion (26) provided between the first connection portion and the second connection portion.” Accordingly, the Examiner has characterized Isaak as teaching that through hole 32 and pad 26 of Isaak as respectively corresponding to Applicant’s claimed “first connection portion” and “metal material portion,” as recited in claim 9.

Isaak, however, teaches that pad 26 is connected to a terminal of integrated circuit chip 70, as shown in FIG. 1. In addition, through hole 32 is electrically connected to pad 26, as shown in FIGS. 1-3. Accordingly, Isaak discloses that both of through hole 32 and pad 26 are electrically connected to a terminal of integrated circuit chip 70. Isaak, thus fails to teach at least the elements “a first connection portion spaced from the first connection terminals and not electrically connected to any terminal of the integrated circuit chip,” and “a metal material portion ... not electrically connected to any terminal of the integrated circuit chip,” as recited in claim 9.

Since Isaak fails to teach each and every element of claim 9, that reference cannot anticipate claim 9. Accordingly, Applicant respectfully requests that the rejection of claim 9 under 35 U.S.C. § 102(e) be withdrawn.

Claims 10, 11, 13, 15, and 16 depend from claim 9, and are thus allowable for at least the same reasons as claim 9. Accordingly, Applicant respectfully requests that the rejection of claims 10, 11, 13, 15, and 16 under 35 U.S.C. § 102(e) be withdrawn.

B. Imoto

Applicant notes that the Examiner has rejected claims 9-12 and 16 under 35 U.S.C. § 102 (e). Since Imoto is not a U.S. Patent, a U.S. Patent Application Publication, or a PCT Publication designating the U.S. and published in English, Imoto is not available as a reference under 35 U.S.C. § 102(e). See M.P.E.P. § 2136, 8th Ed. (Rev. 2), May, 2004. Applicants acknowledge, however, that Imoto may still be available as a reference under 35 U.S.C. §§ 102(a), 102(b). See M.P.E.P. §§ 2132, 2133, 8th Ed. (Rev. 2), May, 2004. Regardless of the particular section of 102 that is applied, Imoto cannot anticipate claim 9, because Imoto fails to teach at least the “a first connection portion spaced from the first connection terminals and not electrically connected to any terminal of the integrated circuit chip,” and “a metal material portion ... not electrically connected to any terminal of the integrated circuit chip,” as recited in claim 9.

At page 5 of the Office Action, the Examiner states that Imoto teaches “a first connection portion (31a) spaced from the first connection terminals (7) [See fig. 8].” Further, at page 6 of the Office Action, the Examiner states that Imoto teaches “a metal material portion (please note that via 31a also includes conductive 2 and 7, as shown in

figures 4).” Apparently, the Examiner has characterized Imoto as teaching that ground line 31a (which includes electrodes 2 and 7 and lands 3 and 17) corresponds to Applicants’ claimed “first connection portion” and “metal material portion,” as recited in claim 9. According to the Applicant, and as is shown in FIGS. 4 and 8, however, Imoto teaches that ground line 31a is electrically connected to a terminal of integrated circuit chip 5 through land 17 and wire (interconnect) 8. Since ground line 31a is electrically connected to a terminal of an integrated circuit chip, this cannot constitute a teaching of “a first connection portion spaced from the first connection terminals and *not* electrically connected to any terminal of the integrated circuit chip,” and “a metal material portion ... *not* electrically connected to any terminal of the integrated circuit chip” as recited in claim 9 (emphasis added).

Since Imoto fails to teach each and every element recited in claim 9, Imoto cannot anticipate claim 9. Accordingly, Applicants respectfully request that the rejection of claim 9 under 35 U.S.C. § 102(e) be withdrawn.

Claims 10-12 and 16 depend from claim 9, and are thus allowable for at least the same reasons as claim 9. Accordingly, Applicants respectfully request that the rejection of claims 10-12 and 16 under 35 U.S.C. § 102(e) be withdrawn.

## **II. Rejection under 35 U.S.C. § 103(a)**

Regarding the rejection of claim 14 under 35 U.S.C. § 103(a), Applicant respectfully disagrees with the Examiner’s arguments and conclusions as set forth in the outstanding Office Action. Accordingly, Applicant respectfully traverses this rejection.

To establish a *prima facie* case of obviousness under 35 U.S.C. §103(a), each of three requirements must be met. First, the reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. See MPEP §2143.03, 8th Ed. (Rev. 2), May, 2004. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Moreover, each of the three requirements must “ be found in the prior art, and not be based on applicant’s disclosure. ” See MPEP § 2143, 8th Ed. (Rev. 2), May, 2004.

Claim 14 depends from claim 9, and thus requires all of the elements recited in claim 9. As discussed above, Imoto fails to teach each and every element recited in claim 9, failing to teach at least “a first connection portion spaced from the first connection terminals and not electrically connected to any terminal of the integrated circuit chip,” and “a metal material portion ... not electrically connected to any terminal of the integrated circuit chip.” Glenn fails to cure these deficiencies.

At page 7 of the Office Action, the Examiner states that Glenn teaches:

first connection terminals *electrically (22) connected to terminals* of the integrated circuit chip (24) [see fig. 4, col. 3, lines 66-67 and col. 4, lines 1-2] ... including second connection terminals *electrically connected* to the first connection terminals. (Emphasis added).

Accordingly, Glenn teaches electrically connecting the terminals of integrated circuit chip 24 to first connection terminals 22. Thus, Glenn fails to teach or suggest at least the elements “a first connection portion spaced from the first connection terminals and

not electrically connected to any terminal of the integrated circuit chip,” and “a metal material portion ... not electrically connected to any terminal of the integrated circuit chip,” as recited in claim 9, and required by claim 14. Since the references, whether taken alone or in combination, fail to teach or suggest each and every element of claim 14, the Examiner has failed to establish a *prima facie* case of obviousness.

Accordingly, Applicant respectfully requests that the rejection of claim 14 under 35 U.S.C. § 103(a) be withdrawn.

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: September 13, 2005

By:   
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Reg. No. 57,460